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Attorney Docket No.: 03399.P031 Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application for:

David A. Chen et al.

Serial No.: 09/640,902

Filing Date: August 16, 2000

For: METHOD AND APPARATUS FOR PROVIDING INTERNET CONTENT TO SMS-BASED WIRELESS DEVICES

Examiner: Bayard, Djenane M.

Group Art Unit: 2141

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RESPONSE TO FINAL OFFICE ACTION

Dear Sir:

In response to the Final Office Action mailed on April 26, 2004, please reconsider the present application in view of the following remarks.

Applicant respectfully traverses the rejections in the Final Office Action and maintains the arguments submitted in Applicants' previous response. The Final Office Action includes two significant errors.

First, the Final Office Action is incorrectly based on the status of the claims prior to the last amendment (filed on February 17, 2004). Specifically, the Final Office Action ignores the fact that claim 1 was amended in the last amendment to incorporate the limitations of claim 2, i.e., to add the limitation, "including generating an SMS message including the content" (claim 46 was amended in a similar manner). The Final Office

Action also rejects claim 2, which was canceled in the last amendment. For at least this reason, the rejection is improper and should be withdrawn.

Second, the Examiner has clearly misunderstood Applicants' remarks on pages 14-15 of the last amendment relating to § 103(c), causing the Examiner to improperly maintain the § 103 rejection. The Examiner finds those remarks unpersuasive, stating (Final Office Action, pages 24-25):

> As per applicant's arguments that the Schwartz et al. (6,473,609) reference does not qualify as prior art under 35 U.S.C. § 103(c), it is noted that **at the time of the invention, filing date 8/16/2000, Phone.com was a separate entity from Openwave Systems Inc**. As per applicant's arguments on page 15, "Phone.com changed its name to Openwave Systems Inc. on November 17, 2000 due to a merger". Therefore, the Schwartz reference qualifies as prior art under 35 U.S.C. § 103. (Emphasis added.)

The Examiner's statement is wrong and seems to be based on a misreading of Applicants' remarks on pages 14-15 of the last amendment. The Examiner is respectfully requested to reread those remarks, in view of the following clarification, and to reconsider the rejection.

At the time of the invention, and on the filing date of the present application's filing date (8/16/2000), Openwave Systems Inc. did not exist yet. As indicated in Applicants' previous remarks, Openwave Systems Inc. was created on or about November 17, 2000, as the result of a merger of Phone.com with another company. Therefore, the Examiner is wrong to contend that "at the time of the invention, filing date 8/16/2000, Phone.com was a separate entity from Openwave Systems Inc.", since Openwave Systems Inc. did not yet exist on that date.

As stated in the last amendment, the cited subject matter in Schwartz and the subject matter claimed in the present application were owned by, or subject to an obligation of assignment to, the same "person" -- Phone.com, Inc. -- at the time the present invention was made. Therefore, Schwartz is not effective as prior art under 35 U.S.C. § 103. Applicants again respectfully submit that, for this reason, all of the rejections under § 103 have been overcome.

Regarding claim 1, because claim 2 (previously canceled) was rejected under 35 U.S.C. § 103 based on Schwartz and another reference, and the limitations of claim 2 are now incorporated into claim 1, claim 1 cannot be rejected under 35 U.S.C. § 103 based on Schwartz. For the same reasons, independent claim 46 also cannot be rejected under 35 U.S.C. § 103 based on Schwartz.

For the above reasons, Applicants respectfully submit that all of the rejections have been overcome. The present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 6/14/04

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